

**REMARKS**

Upon entry of the instant Amendment, claims 16 and 24 is canceled, claims 1, 10-12, 21 and 22 are amended, and claims 25-28 are added. Claims 1-7, 9-17, 21, 22 and 25-28 will be pending in the application with claims 1, 12 and 21 being independent. Support for the amendment to claims 1, 12 and 21 and new claims 25-28 are provided in at least Fig. 1 of the drawings. No new matter is added. Reconsideration of the objections and rejections in view of the above amendments and the following remarks is respectfully requested.

***Claim Objections***

Claims 12 and 16 were objected to as containing informalities.

By this Amendment, Applicants submit that this basis of objection has been rendered moot at least because claim 16 has been canceled and because claim 12 has been amended consistent with the Examiner comments. Applicants note that Fig. 1 clearly shows the first binding member 108 traversing the length of the second constraining wall 104.

With regard to the Examiner's argument that the independent claims recite inconsistencies because the claim preambles recite "open ends" whereas the body of the claims define one or more partially open ends, Applicants submit that such features are not inconsistent. The term "open end" is not defined only as completely open (as the Examiner apparently believes), and instead encompasses ends with any size opening(s). Furthermore, the Examiner has failed to explain how such language would

be confusing one having ordinary skill in the art having read the specification and drawings.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the objection of the above-noted claims.

### **35 U.S.C. § 102 Rejection**

Claims 1, 4-7 and 9-11 were rejected under 35 U.S.C. § 102(b) for being allegedly anticipated by U.S. Patent No. 5,549,202 to WHITESIDE.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, a single prior art reference must disclose each and every element as set forth in the subject claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that a *prima facie* case of anticipation cannot be established because WHITESIDE fails to teach each and every element of the claims as amended.

More particularly, amended independent claim 1 recites, *inter alia*,

an end of the first constraining wall being folded over to form an end cap that is adapted to protect an end product of the stack and add rigidity to the flat mail sleeve packaging system.

Applicants submit that WHITESIDE does not disclose, or even suggest, at least these features. Applicants acknowledge, for example, that WHITESIDE teaches a U-shaped envelope for packaging carton containers (see Abstract). Nor do Applicants dispute that the disclosed packaging device utilizes which could arguably be characterized folded over end caps 21 (see Fig. 2). However, it is apparent from the

figures that the disclosed tabs 21 are formed from non-end portions of the constraining wall 5. The invention, on the other hand, utilizes folded over end(s) of the first constraining wall to form the end cap(s). Thus, WHITESIDE cannot be read to disclose, or even suggest, that an end of the first constraining wall is folded over to form an end cap that is adapted to protect an end product of the stack and add rigidity to the flat mail sleeve packaging system.

Applicants also submit that the disclosed packaging device is unlike the instant invention in at least one important aspect. The invention provides for a "flat mail sleeve packaging system" and that "the product can be unbound and set on an automatic feeder at a postal delivery facility without any further processing. In this manner, manual operations need not be performed on the stacks prior to mail sorting." WHITESIDE, on the other hand, discloses a packaging envelope for "cereal, soap, biscuits, coffee, tea, milk and the like" (see col. 1, lines 9-10). Such a device is clearly not designed or adapted for "flat mail" and/or for an automatic feeder.

Accordingly, Applicants respectfully submit that independent claim 1 as well as dependent claims 4-7 and 9-11, which depends from claim 1 are allowable.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 102(b) should be withdrawn.

### **35 U.S.C. § 103 Rejection**

Claims 2, 3, 12-17, 21, 22 and 24 were rejected under 35 U.S.C. § 103(a) for being allegedly unpatentable over WHITESIDE in view of U.S. Patent No. 1,296,765 to

## CHRISTENSEN.

Applicants respectfully submit that a *prima facie* case of obviousness cannot be established because WHITESIDE and CHRISTENSEN fails to disclose or suggest each and every element of the claims as amended.

More particularly, amended independent claim 1 recites, *inter alia*,

A flat mail sleeve packaging system having opposite facing open ends and being adapted to stack product with bound and non bound edges in a constrained homogenous mass, and an end of the first constraining wall being folded over to form an end cap that is adapted to protect an end product of the stack and add rigidity to the flat mail sleeve packaging system.

Additionally, amended independent claim 12 recites, *inter alia*,

A flat mail sleeve packaging system having opposite facing open ends and being adapted to stack product with bound and non bound edges in a constrained homogenous mass, and the end cap having a width that corresponds to the width of the first constraining wall and a length extending only partially across a width of the second constraining wall so as to define a partially opened end of one of the opposite facing open ends.

Furthermore, amended independent claim 21 recites, *inter alia*,

an upper extending constraining wall having a first constraining surface and an overall length defined by corners of folded over first and second ends of the upper extending constraining wall, and the folded over first and second ends of the upper extending constraining wall forming end caps that are adapted to protect end products of the stack and add rigidity to the flat mail sleeve packaging system.

Applicants submit that no proper combination of WHITESIDE and CHRISTENSEN discloses or suggests at least these features. As explained above, while Applicants do not dispute that WHITESIDE teaches a U-shaped envelope for packaging carton containers (see Abstract) and what could arguably be characterized folded over tabs 21 (see Fig. 2), it is apparent from the figures that the disclosed tabs 21

are formed from non-end portions of the constraining wall 5. The invention, on the other hand, utilizes folded over end(s) of the first constraining wall to form the end cap(s). As such, WHITESIDE does not disclose, or even suggest, that an end of the first constraining wall is folded over to form an end cap that is adapted to protect an end product of the stack and add rigidity to the flat mail sleeve packaging system (claim 1).

Furthermore, as the tabs 21 of WHITESIDE has a width which is significantly less than a width of the wall 5, WHITESIDE cannot be read to disclose that the end cap has a width that corresponds to the width of the first constraining wall and a length extending only partially across a width of the second constraining wall so as to define a partially opened end of one of the opposite facing open ends (claim 12).

Finally, it is apparent that the folded over tabs 21 of WHITESIDE result in a device wherein the overall length of the wall 5 is greater than a length between the corners formed by the folded over tabs 21. As such, WHITESIDE cannot be read to disclose, or even suggest, that the upper extending constraining wall has a first constraining surface and an overall length defined by corners of folded over first and second ends of the upper extending constraining wall.

CHRISTENSEN does not cure the above-noted deficiencies of WHITESIDE. While Applicants do not dispute that CHRISTENSEN teaches a wrapper for packaging magazines (see page 1, lines 8-16) and that the disclosed wrapper utilizes first and second binding members (see Fig. 1), it is apparent from Fig. 3 that the ends of the wrapper are closed off by walls 6. As such, CHRISTENSEN does not disclose, or even suggest, a flat mail sleeve packaging system having opposite facing open ends. Nor

can the Examiner properly argue that CHRISTENSEN teaches the recited end caps forming the open ends.

Accordingly, Applicants respectfully submit that independent claims 1, 12 and 21 as well as dependent claims 2, 3, 13-17 and 22, which depends from claims 1, 12 and 21 are allowable.

Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) should be withdrawn.

***Request for Rejoinder of Non-Elected Claims***

Applicants further submit that rejoinder of withdrawn claims is now proper, because the withdrawn claims depend from claims 1 and 12 which are believed to be allowable. Applicants refer the Examiner to MPEP 821.04 which indicates that withdrawn claims which depend from or otherwise include all the limitations of the allowable claims will be rejoined if presented prior to allowance and issuance of a final rejection. Accordingly, Applicants request that the Examiner rejoin these claims directed to the non-elected invention and consider the merits of the same.

***New Claims are also Allowable***

Applicants submit that the new claims 25-28 are allowable over the applied art of record. Specifically, claims 25-28 respectfully depend from claims 1 and 12 which are believed to be allowable. Additionally, claims 25-28 recite a combination of features which are clearly not disclosed or suggested by the applied art of record. Accordingly,

Applicants respectfully request consideration of these claims and further request that the above-noted claims be indicated as being allowable.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Respectfully submitted,  
B. H. HANSON, *et al.*

A handwritten signature in dark ink, appearing to read 'Andrew M. Calderon', is written over the typed name.

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